



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,203	02/25/2002	Tadataka Matsubayashi	500.41226X00	2859

24956 7590 06/13/2006

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
----------	--------------

2163

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,203

Applicant(s)

MATSUBAYASHI ET AL.

Examiner

Marc R. Filipczyk

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,6 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,6 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/17/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This Action is responsive to Applicant's amendment filed on April 17, 2006.

Claims 3, 6 and 9 have been amended and are pending.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 4/17/06 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the IDS is being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3, 6 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention accomplishes a practical application and whether it generates a useful, concrete and tangible result.

The guidelines explain that a practical application of a 35 U.S.C. 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

In the present case, independent claims 3, 6 and 9 do not involve transformation of article or physical object to a different state or thing, they merely recite extracting and calculating a similarity between words. Further, independent claims 3, 6 and 9 do not produce a useful, concrete, and tangible result, but merely involve a coefficient for calculating similarity. There is no useful, concrete and tangible result as required in the guidelines explained above.

Since the claimed invention, as a whole, does not comprise a practical application as explained above, claims 3, 6 and 9 are rejected for non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, the segment, “distance being calculated by term appearance positions” is indefinite. It is not clear what the term appearance position is and how the distance is calculated with respect to the term appearance. Next, the feature of “calculator processor for calculating similarity by involving the weighting coefficient” is indefinite. It is not clear what similarity and how similarity is calculated. To Multiply a weighting coefficient requires at least another term/number to perform the multiplication.

Regarding claims 3 and 9 comprise the same subject matter as claim 6 respectively, and are therefore rejected on the same basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 6 and 9 are rejected under 35 U.S.C. 102(b) as best as the Examiner is able to ascertain as being anticipated by Noguchi et al. (U.S. Number 5,991,755).

Regarding claims 3, 6 and 9, Noguchi discloses a similar document search method, system, and program for searching for a document similar to a specified (seeds) document, comprising (see abstract):

A memory for storing the document database having documents and information concerning the documents (fig. 6, items 11 and 19 and related text);

A processor for processing data of the document database comprising (fig. 6 and col.1, lines 5-15):

a document analyzer processor for extracting at least one characteristic word from the seeds document including desired retrieval contents (fig. 6, item 18, and col. 5, lines 46-49);

a characteristic word extractor processor (fig. 6, item 15) for extracting as characteristic words of the seeds document, if the characteristic word extracted by the document analyzer processor is a compound characteristic phrase constructed by a plurality of constituent

Art Unit: 2163

characteristic words (col. 10, lines 8-16), and the constituent characteristic words included in the characteristic phrase;

(Note 1: all the steps performed on registered documents are also performed on the seeds document, see col. 11, lines 1-4)

(Note 2: compound characteristic word constructed by a plurality of constituent characteristic words is interpreted as a sentence and words in the sentence, respectively)

a seeds document similarity calculator processor for calculating, according to the characteristic words extracted by the characteristic word extractor processor, similarity between the seeds document and a registration document and the document stored on the document database, by using the characteristic words including the compound characteristic phrase and the constituent characteristic words by which the compound characteristic phrase is constructed (fig. 6, items 22, 24, abstract and related text); and

a retrieval result output processor for outputting a retrieval result as a result of the similarity calculated by the seeds document similarity calculator processor (fig. 6, item 17), wherein analyzing a compound characteristic word including a plurality of characteristic words (col. 10, lines 8-16) is performed and a weighting coefficient and calculator for calculating (distance) similarity is obtained (fig. 6, item 23, col. 9, lines 22-35).

(Note: similarity is equated with distance, the more similar the documents are the closer the documents are)

Response to Arguments

Art Unit: 2163

Applicant's amendment and arguments filed on April 17, 2006 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant argues on page 10 of the 4/17/06 response, that Noguchi does not teach a "calculation based on the distance between the retrieval words in the document".

Examiner disagrees. Noguchi discloses comparing and finding similar documents (see rejection). Similarity alone can be understood as distance, wherein the more similar the documents are the closer they are in distance. Examiner notes that the argued feature is rejected under 35 U.S.C. 112, second par. as being indefinite and is not clearly claimed. In order to calculate a similarity between terms based on their position and distance, the position of the terms and distance between the terms must be compared to some other term or condition.

As such, the argued element of the claim is rejected as best as the Examiner is able to ascertain that which is claimed.

With respect to all the pending claims 3, 6 and 9, Examiner respectfully traverses Applicant's assertion based on the discussion and rejection cited above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2163

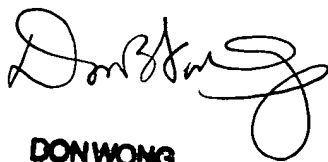
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MF
May 30, 2006

DON WONG
SUPERVISORY PATENT EXAMINER